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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,678	11/12/2003	Gene Michal	50623.352	9070
7590 Cameron K. Kerrigan Squire, Sanders & Dempsey L.L.P. Suite 300 1 Maritime Plaza San Francisco, CA 94111				
05/12/2008				
EXAMINER				
STEWART, ALVIN J				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
05/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,678

Applicant(s)

MICHAL, GENE

Examiner

Alvin J. Stewart

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/19/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/CB/CIC)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed 02/19/2008 have been fully considered.

After a careful examination of the Applicant's remarks regarding the 112 first paragraph rejection, the Examiner withdraw the rejection. However, the Examiner still believes that the 102 rejection is still proper. For example, the Applicant's representative discloses that the esters of a carboxylic acid and metal salts of a carboxylic acid are totally different chemical entities from the carboxylic acid material that the Applicant is claiming.

The Examiner disagrees with the Applicant's representative point of view because the Applicant is only claiming a carboxylic acid and is not positively claiming a specific chemical entity as mentioned by the Applicant's representative. Therefore, no-matter the Wang II reference show carboxylic acids with totally different chemical entities, they are still carboxylic acids and the Examiner is just giving the broadest interpretation of the claims. Therefore, the Examiner believes that the carboxylic acids of the Wang II reference still read on the carboxylic acid of this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 44-46 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al US Patent 5,631,328.

Wang et al discloses a method of making a coat having the step of adding a copolymer of comonomer ethylene with a carboxylic acid comonomer to a solvent system to form a composition (see col. 2, lines 52-60); applying the composition to an implantable medical device (see col. 17, lines 38-42) and allowing the solvent system to evaporate (see col. 8, lines 62-65). The meaning of the word comonomer is the following: one of the compounds that constitute a copolymer. Therefore, the Examiner believes that the reference still reads on the claims because the two compounds mentioned in the claim are part of a copolymer.

Regarding claim 45, see col. 3, lines 43 and 54.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47, 48 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al US Patent 5,631,328 in view of Chabreck et al US Patent 6,087,412.

Wang et al discloses the invention substantially as claimed. However, Wang et al does not disclose a solvent system made of toluene.

Chabreck et al discloses a solvent made of toluene for the purpose of having an inert solvent (see col. 9, lines 65-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the solvent of the Wang et al reference with the toluene solvent of the Chabreck et al reference in order to have an inert solvent.

Regarding claims 50-52, disclose the claimed invention except for having a carboxylic acid comonomer between 5 to 50 percent by weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the percentage by weight of the copolymer, since it has been held that finding an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al US Patent 5,631,328 in view of Kliment et al US Patent 4,729,914.

Wang et al discloses the invention substantially as claimed. However, Wang et al does not disclose a chlorinated solvent.

Kliment et al teaches a copolymer having a solvent and the solvent is chlorinate for the purpose of obtaining an organic liquid which is relatively easy to evaporate at room or slightly elevated temperatures (see col. 4, lines 4-14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Wang et al reference with the Kliment reference in order to obtain an organic liquid which is relatively easy to evaporate at room or slightly elevated temperatures.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Stewart/
Primary Examiner, Art Unit 3774

May 08, 2008.